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MAY 24 2005

In re Application of:
Brian Samuel Beaman et al.
Serial No.: 09/254,769
Filed: March 11, 1999
Attorney Docket No. YO996-184N

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.181, filed March 25, 2005, to withdraw the holding of abandonment of the above-identified application, or in the alternative, to revive the application under 37 C.F.R. § 1.137(a)¹.

The petition is DENIED.

This application was held abandoned for failure to timely file a reply within the meaning of 37 C.F.R. § 1.113 to the final Office action of April 8, 2004. A Notice of Abandonment was mailed on March 15, 2004.

Petitioner asserts that a reply was filed on July 8, 2004 before the shortened statutory period set in the final Office action expired. Petitioner received an Advisory Action response to petitioner's reply on February 10, 2005, four months after the maximum statutory period for reply to the final Office action has expired. Upon receipt of the Advisory Action, petitioner immediately submitted an amendment on February 10, 2005. On March 18, 2005, petitioner received a Notice of Abandonment dated March 15, 2005, which indicates that the reply filed February 10, 2005, was received after the statutory period for replied has expired on July 8, 2004.

Petitioner stated that it was petitioner's intention to discuss the few non-allowed and to pay any applicable extension of time fee necessary claims after receipt of the Advisory Action. Petitioner

¹ This decision addresses the petition to withdraw the holding of abandonment only. The Office of the Deputy Commissioner for Patent Examination Policy will address a decision on the alternative petition to revive under 37 C.F.R. § 1.137(a).

asserts that the delay in issuing the Advisory Action should not be held at the detriment of the applicants as they did respond promptly within the three-month period.

A review of the file record indicates that a reply to the final Office action was timely submitted July 8, 2004, and an Advisory Action was not issued until February 7, 2005. Another reply was submitted February 10, 2005, but was not considered by the examiner as indicated in the Notice of Abandonment mailed March 10, 2005. No extension of time was requested after the final Office action and no Notice of Appeal was filed.

STATUTE, REGULATIONS AND PRACTICE

37 C.F.R. § 1.113(a) states in part that:

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's ... reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116...

37 C.F.R. §§ 1.116(a) and (b) state that:

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After final rejection or other final action (§ 1.113) in an application ... but before or on the same date of filing an appeal (§ 41.31 or 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application ... may be admitted upon showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after final rejection, a final action ... will not operate to relieve the application ... from its condition as subject to appeal or save the application from abandonment under § 1.135 ...

OPINION

The reply to the final Office action filed on July 8, 2004 was timely submitted. The issue to be determined is whether the reply constitutes a proper response to the final Office action within the meaning of 37 C.F.R. § 1.113 and thus stopped the statutory period for reply set in the final Office action. The reply filed July 8, 2004 did not place the application in condition for allowance as evidenced by the Advisory Action mailed February 7, 2005, refusing entry of the amendment.

Under current practice, after an Office action is made final, it is incumbent upon an applicant to take appropriate steps to ensure against the abandonment of his/her application. Because the reply to the final Office action submitted is not deemed to place the application in condition for allowance, the reply required may be a Notice of Appeal or the filing of a Request for Continued Examination (RCE) and requisite fees. Because the reply filed July 8, 2004 did not place the application in condition for allowance and a Notice of Appeal or an RCE was not filed within the maximum statutory period for reply, the statutory period set in the final Office action continued to run from its mail date. While it is regrettable that the USPTO did not timely consider the proposed after final amendment and did not issue an Advisory Action before the expiration of the maximum statutory period, there is no provision in the statute or rule that permits stopping or resetting a statutory period in an Advisory Action as requested by petitioner.

The amendment of February 10, 2005 was not timely filed because it was submitted after the maximum statutory period for reply set in the final Office action has expired and after the application became abandoned. Because this abandonment occurred by operation of law, the USPTO lacks authority to waive or suspend a requirement of the statute or an operation of law and consider this amendment.

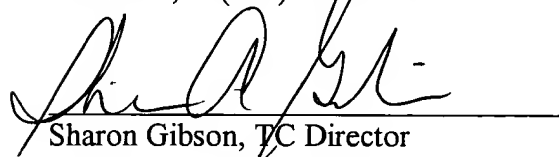
In view of the absence of a timely filing of an amendment that places the application in condition for allowance, of a Notice of Appeal, or of an RCE, the application became abandoned by operation of law. The petition under 37 C.F.R. § 1.181 to withdraw the folding of abandonment cannot be granted.

CONCLUSION

The petition to withdraw the holding of abandonment is denied.

The application is being referred to the Office of the Assistant Commissioner for Patent Examination Policy, Office of Petitions, for a decision on the alternative petition to revive under 37 C.F.R. § 1.137(a).

Questions regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.



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